

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 123-158 were pending in the application, of which Claims 123 and 148 are independent. In the Office Action dated January 23, 2009, Claims 156 was rejected under 35 U.S.C. § 112 and Claims 123-158 were rejected under 35 U.S.C. § 103(a). Following this response, Claims 123-127 and 132-162 remain in this application with Claims 128-131 being canceled without prejudice or disclaimer and new Claims 159-162 being added by this Amendment. Applicants hereby address the Examiner's rejections in turn.

I. Change to Attorney Docket Number

Please note that the Attorney Docket Number for this application is now **60374.0004USI3**.

II. Rejection of Claim 156 Under 35 U.S.C. §112, First Paragraph

In the Office Action dated January 23, 2009, the Examiner rejected Claim 156 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way to reasonably convey to one skilled in the art, at the time the application was filed, that the inventor had possession of the claimed invention. Claim 156 has been amended, and Applicants respectfully submit that the amendment overcomes this rejection and adds no new matter.

III. Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 123-143, 147-149, and 157-158 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,625,302 (“*White*”) in view of International Patent Publication No. WO 00/04726 (“*Lewis*”). In addition, the Examiner rejected Claims 132 and 150 under 35 U.S.C. § 103(a) as being unpatentable over *White* in view of *Lewis* and U.S. Patent No. 6,614,988 (“*Sampsell*”), Claims 133-135, 146, and 151-152 under 35 U.S.C. § 103(a) as being unpatentable over *White* in view of *Lewis* and U.S. Patent No. 6,501,902 (“*Wang*”), Claims 136-139 and 153-155 under 35 U.S.C. § 103(a) as being unpatentable over *White* in view of *Lewis* and U.S. Patent No. 6,098,082 (“*Gibbon*”), Claims 140-141 under 35 U.S.C. § 103(a) as being unpatentable over *White* in view of *Lewis*, *Gibbon*, and U.S. Patent No. 6,101,512, Claims 144-145 under 35 U.S.C. § 103(a) as being unpatentable over *White* in view of *Lewis* and U.S. Patent No. 5,861,906 (“*Dunn*”), and Claim 156 under 35 U.S.C. § 103(a) as being unpatentable over *White* in view of *Lewis*, U.S. Patent No. 6,671,328 (“*Poon*”), and U.S. Patent No. 5,790,940 (“*Laborde*”). Claims 123 and 148 have been amended, and Applicants respectfully submit that the amendments overcome this rejection and add no new matter.

Amended Claim 123 is patentably distinguishable over the cited art for at least the reason that it recites, for example, “responsive to storing the information in the memory, providing by the STT feedback that the bookmarking of the visual scene has occurred, wherein providing the feedback comprises, while outputting the first portion of the VOD presentation, overlaying a displayed portion of the VOD presentation with one of the following: a banner and an icon indicating that the visual scene has been

bookmarked.” Amended Claim 148 is patentably distinguishable over the cited art for at least the reason that it recites, for example “retrieve by the STT a data structure containing pre-assigned bookmark names for various scenes of the VOD presentation; provide by the STT, without interrupting the VOD presentation, the pre-assigned bookmark names for selection; receive at the STT a second user input indicative of one of the following: a selected pre-assigned bookmark name of the provided pre-assigned book mark names and a user-customized name to be associated with the visual scene.” Support for these amendments can be found in the specification at least on page 13, line 17 – page 14, line 4.

In contrast, and as stated by the Examiner, *White* does not disclose bookmarking a visual scene. (See page 3, point 5.) Consequently, *White* cannot disclose providing pre-assigned bookmark names associated with visual scenes because *White* fails to disclose bookmarking visual scenes. Moreover, *White* cannot disclose providing an indication that a visual scene has been bookmarked because *White* fails to disclose bookmarking visual scenes.

Furthermore, *Lewis* does not overcome *White*’s deficiencies. For example, *Lewis* merely discloses that a text display provides user prompts to assist a user in navigating through a display and setting and erasing bookmarks. (See page 6, lines 21-22.) In *Lewis*, the user selects a desired button to set a bookmark or erase a bookmark. (See page 6, lines 28-29.) *Lewis*’ text display indicates that the user can set a bookmark by pressing an “OK” key on a remote control device. (See page 6, lines 30-31.) However, *Lewis* fails to disclose providing an indication that a visual scene has been bookmarked. Moreover, nowhere does *Lewis* disclose providing pre-

assigned bookmark names associated with visual scenes. Rather, *Lewis* merely discloses that a text display assists a user in setting and erasing bookmarks and fails to disclose pre-assigned bookmark names or providing any bookmark storage indication.

Combining *White* with *Lewis* would not have led to the claimed invention because *White* and *Lewis* either individually or in combination, at least do not disclose “responsive to storing the information in the memory, providing by the STT feedback that the bookmarking of the visual scene has occurred, wherein providing the feedback comprises, while outputting the first portion of the VOD presentation, overlaying a displayed portion of the VOD presentation with one of the following: a banner and an icon indicating that the visual scene has been bookmarked,” as recited by amended Claim 123, and “retrieve by the STT a data structure containing pre-assigned bookmark names for various scenes of the VOD presentation; provide by the STT, without interrupting the VOD presentation, the pre-assigned bookmark names for selection; receive at the STT a second user input indicative of one of the following: a selected pre-assigned bookmark name of the provided pre-assigned book mark names and a user-customized name to be associated with the visual scene,” as recited by amended Claim 148. Accordingly, independent Claims 123 and 148 each patentably distinguish the present invention over the cited art, and Applicants respectfully request withdrawal of this rejection of Claims 123 and 148.

Dependent Claims 124-127, 132-147, and 149-158 are also allowable at least for the reasons described above regarding independent Claims 123 and 148, and by virtue of their respective dependencies upon independent Claims 123 and 148. Accordingly, Applicants respectfully request withdrawal of this rejection of dependent Claims 124-127, 132-147, and 149-158.

IV. New Claims

Claims 159-162 have been added to more distinctly define and to round out the protection for the invention to which Applicants are entitled. Applicants respectfully submit that these claims are allowable over the cited art and that they add no new matter.

V. Conclusion

In view of the foregoing, Applicants respectfully submit that the pending claims, as amended, are patentable over the cited references. The preceding arguments are based only on the arguments in the Official Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Official Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such

statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 19-0761.

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Date: April 22, 2009

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